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EXAMINER	
GRAYSAY, TAMARA L	
ART UNIT	**PAPER NUMBER**
3623	

DATE MAILED: 10/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/819,264	UEDA, SATORU	
	Examiner	Art Unit	
	Tamara L. Graysay	3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 March 2005 and 07 July 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-11* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-11* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *07 July 2005* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *(1 page)*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

EXPLANATION OF SHORTHAND REFERENCE USED THIS OFFICE ACTION:
CLAIM 1 IS REFERRED TO BY THE PREAMBLE AND TWELVE PARAGRAPHS.
CLAIMS 9-11 ARE REFERRED TO IN A MANNER SIMILAR TO CLAIM 1.

Preliminary Matter

The amendments filed 10 March 2005 and 07 July 2005 have been entered.

Priority

1. Receipt is acknowledged of papers submitted 28 March 2001 under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

2. The listing of the documents provided on the PTO-1449 have been lined through because only a copy of the online abstract was submitted, not the foreign patent documents. However, in the interest of compact prosecution, the examiner has listed on the attached PTO-892 the information that was considered.

Drawings

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "display" recited in claim 1, seventh paragraph, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be

renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

4. Claims 2 and 9 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

In the present application, claim 2 is dependent upon base claim 1. The fourth paragraph of the base claim recites polling information for "the picture content" which is defined in the preamble as picture content. In contrast, dependent claim 2 includes "a portion" of the picture content. Thus, it appears that applicant is improperly attempting to modify claim 2 such that all of the limitations of base claim 1 are not included therein.

Claim 9 is confusing as written because the elements recited in the second through fifth paragraphs are part of the element recited in the first paragraph, i.e., the contents introduction information sending means (11b), polling information receiving means (11c), polling information storage means (11d), and poll result counting means (11e) are part of the contents market research apparatus (11) just as the contents introduction information storage means (11a). See figure 1.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-8, 10 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. Claim 1, fourth paragraph – "the contents polling information" lacks antecedent basis in the claim. The recitation of "said polling information" has been interpreted to be the polling information given by a pollee as set forth in the preamble.

b. Claim 1, fifth paragraph – "said contents polling information" is confusing because "polling information given by a pollee," "the contents polling information" including the polling information for the picture content and "the contents polling information" are recited in antecedent in the preamble and in the fourth paragraph. The terms should be related to or distinguished from each other.

c. Claim 1, sixth paragraph – "said contents polling information entered by a predetermined pollee" and "said contents polling information entered by general pollee" lack antecedent basis in the claim.

d. Claim 1, seventh paragraph – "the business profitability" lacks antecedent basis in the claim; and "said display apparatus" lacks antecedent basis in the claim, i.e., the term was deleted by amendment to the preamble of claim 1. Further, "the content" lacks antecedent basis because both "picture content" and content introduction information" are recited in antecedent.

e. Claim 1, eleventh paragraph – "said contents polling information" lacks antecedent basis because contents polling information received by means of the contents polling information receiving means, contents polling information entered by a predetermined pollee, and contents polling information entered by general pollee are each recited in antecedent. Thus, the recitation at the eleventh paragraph is not clear which of the previously recited "contents polling information" is being further limited.

f. Claim 1, twelfth paragraph – "said contents polling information entered by said contents polling means" lacks antecedent basis. Each of "contents polling information that includes said polling information for said picture," "contents polling information received by means of said contents polling information receiving means," "contents polling information entered by a predetermined pollee," and "contents polling information entered by general pollee" are all recited in antecedent. Further, both "contents polling information receiving means" and "contents polling information storage means" are recited in antecedent, for example.

g. Claim 4, "said contents polling information" lacks antecedent basis in that there are several different contents polling information recited in antecedent rendering the claim unclear.

h. Claim 5, "said contents polling information" lacks antecedent basis in that there are several different contents polling information recited in antecedent rendering the claim unclear. Further, "the merchandise purchase intention information" lacks antecedent basis. Further, "said pollee" is unclear because a predetermined pollee and a general pollee are recited in antecedent.

i. Claim 7, "the combination of a plurality of said picture contents" is confusing because there is only one picture content recited in the claim and in the preamble of the claim. Applicant has not provided for more than one picture content in the claim.

j. Claim 8, "said contents polling information" lacks antecedent basis in that there are several different contents polling information recited in antecedent rendering the claim unclear. Further, the term "said merchandise" lacks antecedent basis.

k. Claim 10, third paragraph, the step of sending is incomplete because there is no destination of the sending step. The information that is sent, i.e., the content introduced to the pollees, is recited but there is no recitation as to where the information is sent. Due to the essential nature of the destination for the sending step, the claim is rendered indefinite.

l. Claim 11, is not clear because the preamble is drawn to a method. A method stored on a computer-readable medium is indefinite because a method is comprised of physical acts and physical acts cannot be stored on a computer-readable medium. There is no positive reference to the computer-readable medium in the claim, so the claim is not clear whether it is drawn to a method or an apparatus including the computer-readable medium encoded with instructions to enable the method to be performed. The claim must be clarified as to its scope. It has been treated as a method claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-4 and 7-9 are rejected under 35 U.S.C. 102(e) as being anticipated by DeRafael (US-6529878).

Regarding claim 1, DeRafael discloses a system and apparatus comprising contents market research apparatus (Fig.2) having contents introduction information storage means (20,24), contents introduction information sending means (18, namely the input/output circuitry's output), contents polling information receiving means (18, namely the input/output circuitry's input), contents polling information storage means (24,40), poll result counting means for counting contents polling information entered by pollees (DeRafael discloses that the computer transmits user response information including statistical information, which inherently includes a counting means, C.3, L.28-44) and a display for displaying business profitability when the content is commercialized (the advertiser views the demographic information of pollees who answer yes or follow a pattern, C.3, L.28-44); and contents polling apparatus (Fig.2) having contents introduction receiving means (computer 26), contents introduction information display means (window 28), contents polling means for entering polling information (keyboard 32), and contents polling information sending means for sending information (32,30,20). The particular item (a picture content), as broadly defined in the claim, is met by the advertisements disclosed

in DeRafael. Moreover, the claim does not make any distinction between a predetermined pollee and a general pollee, thus they have been interpreted as a pollee of a certain target audience and a pollee outside that audience respectively. It is inherent in the reference that a categorization of the pollees is accomplished in order to perform the statistical analysis for the advertiser who seeks information about the pollees.

Regarding claim 2, the advertiser's advertisement (interactive advertisement Fig.1) includes part of a picture, as broadly recited (DeRafael discloses that "part of a picture" or even a whole picture is viewed on the user's computer screen).

Regarding claim 3, DeRafael discloses that the information is classified as a function of subject matter insofar as the computer provides a directory or keyword to find information related to a particular subject (C.2, L.60-64).

Regarding claim 4, the contents polling information of DeRafael includes the user's personal information (C.2, L.45-54).

Regarding claim 7, DeRafael, as described in regard to system claim 1 above, the system determines business profitability, as broadly recited, insofar as it generates statistical data (C.3, L.34-37) and the data serves as an aid to advertisers in making business decisions.

Regarding claim 8, the content polling information includes selection of an advertisement by the poller (user)

Regarding claim 9, DeRafael, as described in regard to system claim 1 above, includes all of the structural limitations that are positively recited in apparatus claim 9.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over DeRafael (US-6529878) in view of Video Week (article, Video Notes).

Video Week teaches a market research system which includes intent-to-buy as a consideration for taking a direct-to-sellthrough release of a film on video.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the research system of DeRafael to include intent-to-buy as part of a marketing research poll, such as taught by Video Week, in order to make a determination of whether a direct-to-sellthrough approach is appropriate for a picture or film that is to be released.

8. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over DeRafael (US-6529878) in view of Chisholm (US-5400248).

Chisholm teaches a polling system that includes weighted votes. The vote administrator determines the weight of each vote in order to increase the importance or power of some voters over others.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the research system of DeRafael to include more ballots to one voter than to another voter, such as suggested by the weighted voting system of Chisholm, in order to increase

the importance and power of the polled person who has more than one ballot. One incentive for using a weighted voting system, whereby a particular person who is polled has more ballots, is to increase the power of that person.

9. Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeRafael (US-6529878).

DeRafael discloses introducing picture content to one or more pollees (the advertisement is displayed for the user, e.g., the output of input/output circuitry 18 introduces the information), storing picture content information (computer database 20 stores advertisements at 24), sending stored information (output of input/output circuitry 18, sends the information), receiving polling information (input of input/output circuitry 18, receives user responses), storing polling information (computer database 20 stores the responses), and counting polling information (the computer transmits user response information including statistical information, which is inherently includes a counting step, C.3, L.28-44).

DeRafael lacks the step of determining the business profitability. However, it is disclosed in DeRafael that the computer transmits user response information including statistical information (C.3, L.28-44). This step of transmitting the response information to the advertiser is "useful to advertisers because it aids them in targeting their advertisements and responding to consumer preferences." These disclosed benefits are evidence that the advertisers will use the information provided to them to make business decisions. The examiner takes Official notice that it is well known in the business field to determine profitability of a particular endeavor when

making a business decision. In order to minimize losses or maximize profits, a business decision is made based on profitability of the particular endeavor.

Therefore, it would have been obvious to one of ordinary skill in the art to modify the disclosed method of DeRafael to include a step of determining the business profitability when an advertised product is commercialized in order to minimize losses or maximize profits.

10. Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamara L. Graysay whose telephone number is (571) 272-6728. The examiner can normally be reached on Mon - Fri from 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz, can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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